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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
08/910,115	08/13/1997	BAYCHAR	BAY-310	2266

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MATTINGLY, STANGER, MALUR & BRUNDIDGE, P.C.
1800 DIAGONAL ROAD
SUITE 370
ALEXANDRIA, VA 22314

EXAMINER

JUSKA, CHERYL ANN

ART UNIT	PAPER NUMBER
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1771

DATE MAILED: 05/11/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

08/910,115

Applicant(s)

BAYCHAR,

Examiner

Cheryl Juska

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 24 February 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-4,7-10,13,17,20-32,34,36-38,40-42 and 44-113 is/are pending in the application.
- 4a) Of the above claim(s) 8-10,13,25-32,34,36-38,40-42,44-88 and 91-109 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-4,7,17,20 and 111-113 is/are rejected.
- 7) ☒ Claim(s) 21-24,89,90 and 110 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 24 February 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>02/24/05</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Amendment

1. Applicant's amendment filed February 24, 2004, has been entered. New claims 111-113 have been added. Thus, the pending claims are 1-4, 7-10, 13, 17, 20-32, 34, 36-38, 40-42, and 44-113 with claims 8-10, 13, 25-32, 34, 36-38, 40-42, 44-88, and 91-109 being withdrawn as non-elected.

Specification

2. The substitute specification filed on February 24, 2004, has not been entered because it does not conform to 37 CFR 1.125(b) and (c) because: It does not overcome the objection to the originally filed specification since the trademarks are not accompanied by the appropriate generic terminology. [Note section 3 of the Office Action dated May 24, 2000.]

Terminal Disclaimer

3. The terminal disclaimers filed on February 24, 2005, disclaiming the terminal portion of any patent granted on this application which would extend beyond the expiration date of Application No. 08/887,847 and US Patent No. 6,048,810 have been reviewed and are accepted. The terminal disclaimers have been recorded. As such, the double patenting rejections set forth in sections 5-13 of the last Office Action are hereby withdrawn.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

5. Claims 112 and 113 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Claim 112 includes the limitation “wherein the combination of layers is breathable and each layer is selected based upon performance characteristics that enable moisture to be transferred through the technical apparel from the first layer through the fourth layer at a rate sufficient to maintain comfort of the individuals while they are engaged in activities that generate moisture.” Said limitation is considered new matter since the specification as originally filed does not teach selection based upon “performance characteristics” to produce a moisture transfer “rate sufficient” to maintain comfort. Similarly, the limitation of claim 113 “wherein each layer has technical performance characteristics with respect to breathability and moisture transfer that are suitable for moisture transfer technical apparel” is considered new matter since the specification as originally filed is not enabling for said “technical performance characteristics.”

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

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7. Claims 112 and 113 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

It is unclear what is encompassed by the phrases “performance characteristics” and “technical performance characteristics.”

Claim Rejections - 35 USC § 103

8. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

9. Claim 20 stands rejected under 35 U.S.C. 103(a) as being unpatentable over US 5,431,970 issued to Broun et al. for the reasons of record.

10. Claims 1-4, 7, and 17 stand rejected under 35 U.S.C. 103(a) as being unpatentable over US 5,431,970 issued to Broun et al. for the reasons of record.

11. New claims 111-113 are rejected under 35 U.S.C. 103(a) as being unpatentable over US 5,431,970 issued to Broun et al.

New claim 111 differs from claim 1 in that the breathable layers enable moisture vapor to “quickly” transfer so as to keep the individuals dry “while they are engaged in activities that generate moisture.” These new recitations do not serve to patentably distinguish the present invention from the prior art. Specifically, said recitations are still considered relative terminology. Additionally, the claim merely requires the breathable layer to being capable of moisture transfer. In other words, the recitation is not a positive limitation but only requires the ability to so perform.

The same “capability” argument is made for claims 112 and 113.

Allowable Subject Matter

12. Claims 21-24, 89, 90, and 110 are objected to as being dependent upon a rejected base claim, but would be allowable for the reasons of record if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Response to Arguments

13. Applicant's arguments filed with the amendment of February 24, 2005, have been fully considered but they are not persuasive.

14. Applicant traverses the examiner's reliance upon US 5,876,792 issued to Caldwell to support the Official Notice given that encapsulated Cordura[®] fabrics were known prior to the filing of the present application (Amendment, page 28, 3rd paragraph).

Specifically, applicant asserts said Caldwell '792 patent issued on March 2, 1999, which is after the filing of the present application. Applicant also notes Caldwell's teaching is not supported by the parent patents US 5,004,643 and 5,418,051 and, as such, "does not have the benefit of the effective filing dates of these patents" (Amendment, page 28, 3rd paragraph). The examiner respectfully disagrees. True, the subject matter at issue of the Caldwell '792 patent does not get the benefit of its parent file dates, but it certainly receives benefit of its own filing date of March 17, 1995. The 1995 date is more than sufficient to antedate the present application's effective filing date. Therefore, applicant's argument is found unpersuasive.

15. Applicant also argues that claims 26-28, 32, and 38 have been allowed and, as such, the "recently discovered reference to Broun et al does not affect the allowability of those claims" (Amendment, page 29, 2nd paragraph). In response, it is respectfully noted

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that claims 26-28, 32, and 38 are non-elected claims. This means said claims are not presently being examined on the merits. As such, said claims cannot be “allowed.”

16. Applicant traverses the examiner’s position with respect to the term “breathable.” In particular, applicant believes the examiner is requiring that “breathable” be defined by a specific numerical range (Amendment, page 30, 3rd paragraph). The examiner has not made such a requirement. It was merely stated, “applicant has not specifically defined in the specification the term ‘breathable’ as having a particular rate of moisture transfer. As such, the broadest reasonable interpretation of the term must be employed in examination.” (Office Action of 08/24/04, section 19.) Said term is a relative term and, therefore, cannot serve to patentably distinguish the present invention over the prior art.

17. Additionally, applicant asserts “the specification clearly defines an invention that excludes the breathability characteristics taught by Broun et al.” (Amendment, page 30, 3rd paragraph and paragraph spanning pages 31-32). The examiner disagrees that the specification clearly teaches said “exclusion.” Even if, for arguments sake, the specification contained such a teaching, while the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). Therefore, applicant's argument is unpersuasive.

18. Furthermore, applicant argues the teachings of Broun cannot be applied to apparel (Amendment, page 32, 2nd paragraph – page 33, 1st paragraph, and paragraph spanning pages 33-34). First, it is noted that the entire argument was considered previously. Secondly, the examiner respectfully disagrees and maintains that it would have been obvious to employ the technical fabric of Broun as an apparel fabric in order to provide a

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garment that is waterproof yet breathable. The degree of breathability of the prior art fabric may or may not limit some of the apparel applications, but it would have still been obvious to one skilled in the art.

19. With respect to applicant's argument that one would not apply encapsulation technology to a material that is already water resistant and intended to be disposable (Amendment, page 33, 2nd paragraph), it is first noted that the rejection is not based upon obviousness to *add* encapsulation technology, but rather to *substitute* an encapsulated fabric as the waterproof layer. See Office Action dated March 15, 2004, section 12. Additionally, it is asserted that all fabrics and apparel are capable of being "disposed." Therefore, applicant's arguments are found unpersuasive and the above rejections stand.

Conclusion

20. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the

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advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

21. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Cheryl Juska whose telephone number is 571-272-1477.

The examiner can normally be reached on Monday-Friday 10am-6pm. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Terrel Morris can be reached at 571-272-1478. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

22. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


CHERYL A. JUSKA
PRIMARY EXAMINER

cj
May 6, 2005